

REMARKS

This is intended as a full and complete response to the Final Office Action dated February 8, 2007, having a shortened statutory period for response set to expire on May 8, 2007. Please reconsider the claims pending in the application for reasons discussed below.

Premature Final Office Action

Applicants submit that the finality of the rejection is improper and hereby request withdrawal of its finality. In the previous Response to Office Action dated August 23, 2006, Applicants traversed the rejection without amendment of independent claim 1. Therefore, the new ground of rejection based on newly cited art was not necessitated by Applicants amendment. A subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, of any claim not amended by applicant. M.P.E.P. § 706.07(a). Accordingly, Applicants respectfully request withdrawal of the finality of the present office action.

Drawings

The drawings stand objected to under 37 C.F.R. § 1.83(a). In response, Applicants respectfully traverse the rejection.

First, the present application includes only method claims. The USPTO regards an application that contains a “method claim as an application for which a drawing is not necessary (emphasis added) for an understanding of the invention under 35 U.S.C. 113 (first sentence).” M.P.E.P. § 601.01(f). Acts specified in the claims are thus not physical features that must be shown in the drawings according to 37 C.F.R. § 1.83(a).

Nevertheless, the present application includes a drawing that shows aspects of claimed acts such as those identified by the Examiner. For example, the “...discrete zone...” (claims 1 and 54), “ and the “...discrete zones are circumferentially spaced...” (claim 14) are illustrated by three rollers (reference number 18) shown contacting only certain spaced apart locations of a tubular (10). See, paragraph [0016] of the present application. In addition, pistons (16) in the drawing depict that “...the bearing member is

fluid pressure actuated" (claim 18). While "...a cone swage expander..." (claim 21) is itself not claimed, the drawings show the tubular (10) that appears the same in a drawing regardless of whether or not "the tubular has been previously expanded with a cone swage expander," as recited in claim 21.

Furthermore, the Examiner should only require drawings when the "nature of such subject matter admits of illustration by a drawing." M.P.E.P. § 608.02. Applicants submit that "...a level of the radial force..." (claims 1 and 54) relates to an intangible aspect of the claimed method that does not admit to illustration by a drawing. Based on the foregoing, Applicants submit that the drawings in view of the claims are in compliance with 37 C.F.R. § 1.83(a) and accordingly request withdrawal of the objection.

Claims Rejections - 35 U.S.C. § 112

Claims 12, 26 and 54 stand rejected under 35 U.S.C. § 112, second paragraph. In response, Applicants respectfully traverse the rejection.

Regarding claim 12, the Examiner states that the phrase "such that" is the same as "such as" and renders the claim indefinite. However, the phrase "such that" does not have the same meaning as "such as." Therefore, it is clear that the limitations following the phrase "such that" are part of the claimed subject matter.

With respect to claims 26 and 54, Applicants deleted the term "substantially" in order to further prosecution. Therefore, claims 12, 26 and 54 particularly point out and distinctly claim the subject matter as required under § 112. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim Rejections - 35 U.S.C. § 103

Claims 1-29 and 54-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brenneke* (2,575,938) in view of *Creger et al.* (4,262,518). Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Brenneke* in view of *Creger et al.* and *Zheng et al.* (6,571,870). In response, Applicants respectfully traverse the rejection.

Claims 1 and 54 recite methods of increasing collapse resistance of a tubular that include the act of “selecting a level of the radial force to increase the collapse resistance of the tubular.” However, *Brenneke* is silent with respect to collapse resistance of cylinder liners expanded with a tool disclosed therein much less any act of selecting a radial force level to result in collapse resistance increase. Furthermore, expanding the cylinder liners as disclosed in *Brenneke* does not inherently increase collapse resistance of the cylinder liner. For example, the collapse resistance of the cylinder liner may be decreased upon expansion as would occur if walls of the cylinder liner are thinned by the expansion to an extent that collapse resistance reduces. The cylinder liner is utilized in a cylinder for an engine or compressor such that no collapse issues regarding the liner that is in tight contact with a cylinder exist. *Brenneke* lacks any evidentiary support for teaching, showing or suggesting each and every element of claim 1 or claim 54. Evidentiary support must be in the record as the principal evidence upon which a rejection is based. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir., 2001); MPEP § 2144.04. Furthermore, *Creger et al.* and *Zheng et al.* fail to overcome this deficiency in *Brenneke*.

The Examiner further states that “statements of intended use or field of use, e.g., “is selected to, is subject to, etc.” clauses are essentially method limitations or statements of intended or desired use” and that such “statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference.” However, all the pending claims are directed to methods and not a structure or apparatus as recited in MPEP §§ 2114 and 2115, which are also cited by the Examiner. While the particular phrases identified by the Examiner are not present in the claims, Applicants submit that the claimed “selecting a level of the radial force to...” is an act of a method claim, thereby requiring that a remainder of this limitation describes the metes and bounds of the claimed action and must accordingly be considered with respect to the present § 103 rejection. The claim recitation “...to increase collapse resistance of the tubular” thus cannot be ignored.

Therefore, *Brenneke*, *Creger et al.* and *Zheng et al.* fail to teach, show or suggest a method of increasing collapse resistance as claimed. Since each and every element of claim 1 or claim 54 is not disclosed in the references, the references cannot render

the claims or any claim dependent thereon obvious. Accordingly, Applicants submit that claims 1-29 and 54-56 are allowable and respectfully request allowance thereof.

Conclusion

Having addressed all issues set out in the Final Office Action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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